

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

Paper No. 28

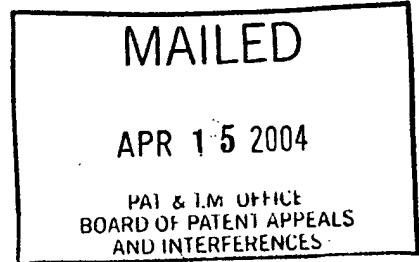
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte PATRICK JOSEPH CALLAGHAN,
MICHAEL JAMES HOWLAND, and STEVEN M. PRITKO

Appeal No. 2003-1031
Application No. 09/050,841¹

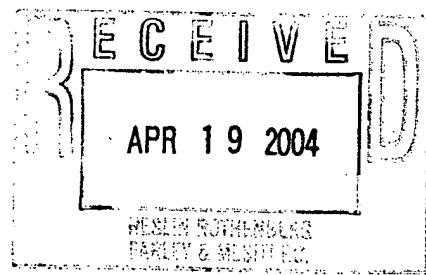
ON BRIEF



Before HAIRSTON, BARRY, and BLANKENSHIP, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-7, 9-27, and 29-52. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm-in-part.



¹The original application was published on January 17, 2002 as Published Application No. 20020007317.

BACKGROUND

The invention at issue on appeal shares "state information" across domains of the Internet's World Wide Web ("WWW").² Modern applications maintain state information such as what a user was doing when he last ran an application or what he prefers for his configuration settings. Because maintaining state information allows a user to tailor an application to his needs, programmers have developed techniques to add state information to the WWW. (Spec. at 1.) "Cookies" are one such technique. More specifically, when responding to a client, a server sends a cookie for the client to store. The cookie includes a range of Uniform Resource Locators for which it is valid. Any future requests from the client to the server falling in that range will include the current value of the cookie. (*Id.* at 2.)

A "virtual shopping mall" is an application that uses cookies. As a user browses through a store of a virtual shopping mall and decides to buy certain items, those items are added to a "shopping cart." More specifically, a list of the chosen items is kept in a

²"The 'World Wide Web' . . . is that collection of servers on the Internet that utilize the Hypertext Transfer Protocol (HTTP). HTTP is a known application protocol that provides users access to resources (which can be information in different formats such as text, graphics, images, sound, video, Hypertext Markup Language--'HTML' etc., as well as programs)." U.S. Patent No. 5,796,952, col. 7, ll. 1-7.

cookie file, i.e., the "shopping cart," of the user's Web browser, so that all of the items can be paid for when the user finishes shopping within that store. (*Id.*)

The appellants explain that cookies, however, have not been shared across domains of the Internet. Because items cannot be tracked from one store to another in the aforementioned virtual shopping mall, for example, the user must check out his purchases at each store. (*Id.* at 4-5.) Because state information is not saved across domains, furthermore, users must log into each domain. (*Id.* at 5.)

In contrast, the appellants insert state information in cookies and use an intermediary application to allow the cookies to be shared across different domains. More specifically, the intermediary application adds the state information to requests from a client and responses thereto. (*Id.* at 52.) A further understanding of the invention can be achieved by reading the following claim.

1. A method of sharing state information, said method comprising:

 determining by an intermediary application state information to be shared between a first domain and a second domain; and

 sharing said state information between said first domain and said second domain, wherein said first domain and said second domain are non-cooperating domains, said non-cooperating domains having no knowledge of one another and wherein said non-cooperating domains do

not directly communicate state information between one another, said sharing of state information being through the intermediary application.

Claims 1-7, 10-17, 22-27, 30-37, 42-49, 51, and 52 stand rejected under 35 U.S.C. § 103(a) as obvious over International Patent Application WO 98/09447 ("Rosenberg") and U.S. Patent No. 5,796,952 ("Davis"). Claims 9 and 29 stand rejected under § 103(a) as obvious over Rosenberg; Davis; and U.S. Patent No. 5,946,665 ("Suzuki").³ Claims 18, 19, 21, 38, 39, 41, and 50 stand rejected under § 103(a) as obvious over Laura Giacoppo ("Giacoppo"), <http://www.dejanews.com>, Forum:comp.lang.java.announce, Thread: ad/soft/Checkout -shopping cart applet and Davis. Claims 20 and 40 stand rejected under § 103(a) as obvious over Giacoppo; Davis; and John Krick ("Krick"), *A Cookie for Your Thoughts: Cookies Help Webmasters Harness User Habits*, Computer Shopper, vol. 17, no. 7, p. 610.⁴

³Although the examiner's statement of the rejection of claims 9 and 29 omits Davis, (Examiner's Answer at 19), claims 9 and 29 respectively depend from claims 1 and 22, which the examiner rejects under Rosenberg and Davis. (*Id.* at 2.) Therefore, we consider the rejection of claims 9 and 29 to include Davis.

⁴Although the examiner's statement of the rejection of claims 20 and 40 omits Davis, (Examiner's Answer at 20), claims 20 and 40 respectively depend from claims 19 and 39, which the examiner rejects under Giacoppo and Davis. (*Id.* at 22.) Therefore, we consider the rejection of claims 20 and 40 to include Davis.

OPINION

Our opinion addresses the claims in the following order:

- claims 1-7, 9, 22-27, 29, 42-46, 51, and 52
- claims 10-17, 30-37, and 47-49
- claims 18-21, 38-41, and 50.

A. CLAIMS 1-7, 9, 22-27, 29, 42-46, 51, AND 52

"[T]o assure separate review by the Board of individual claims within each group of claims subject to a common ground of rejection, an appellant's brief to the Board must contain a clear statement for each rejection: (a) asserting that the patentability of claims within the group of claims subject to this rejection do not stand or fall together, and (b) identifying which individual claim or claims within the group are separately patentable and the reasons why the examiner's rejection should not be sustained." *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (citing 37 C.F.R. §1.192(c)(7) (2001)). "Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." 37 C.F.R. § 1.192(c)(7). "If the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim." *McDaniel*, 293 F.3d at 1383, 63 USPQ2d at 1465.

Here, the appellants argue claims 1-4, 6, 7, 22-24, 26, 27, and 42-46 as a group, viz., "Group I". (Supp. Appeal Br. at 9-13.) Furthermore, they do not separately argue the patentability of claim 5 or claim 25. Therefore, claims 2-7, 22-27, and 42-46 stand or fall with representative claim 1. With this representation in mind, rather than reiterate the positions of the examiner or the appellants *in toto*, we address the following points of contention therebetween:

- non-cooperating domains
- client and server
- proprietary protocol.

1. Non-cooperating Domains

The examiner finds, "Rosenberg discloses . . . sharing said state information between said first domain and said second domain, wherein said first domain and said second domain are non-cooperating domains, said non-cooperating domains having no knowledge of one another and wherein said non-cooperating domains do not directly communicate states information (see page 4, lines 18-27, page 7, lines 1-8 and lines 20-23 distinct domains)." (Examiner's Answer at 2-3.) The appellants argue, "[i]n Rosenberg, state information is shared across cooperating domains, and not across non-cooperating domains." (Supp. Appeal Br. at 9.)

In addressing the point of contention, the Board conducts a two-step analysis.

First, we construe the representative claim at issue to determine its scope. Second, we determine whether the construed claim would have been obvious.

a. Claim Construction

"Analysis begins with a key legal question -- *what is the invention claimed?*"

Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). Here, claim 1 recites in pertinent part the following limitations: "said first domain and said second domain are non-cooperating domains, said non-cooperating domains having no knowledge of one another and wherein said non-cooperating domains do not directly communicate state information between one another. . ." "The phrase 'non-cooperating domains' has been extensively defined in the application and the file history, and is recited in independent claims 1, 22 & 42 to mean that the domains have no knowledge of one another *and* do not directly communicate state information between one another." (Supp. Appeal Br. at 9.) Accordingly, the limitations require domains having no knowledge of one another and being unable to directly communicate state information between themselves.

b. Obviousness Determination

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697(Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembicza*k, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)).

Here, Rosenberg discloses "[a] method of tracking a web browser across distinct domains of a network of computers. . . ." P. 4, ll. 18-19. Figure 1 of the reference represents the distinct domains as "two server computers 24A and 24B, although a typical embodiment of the invention would include a larger number of server computers, say server computers 24A through 24N." P. 6, ll. 8-10. "[I]t is clear from the reference that . . . the servers have distinct domain names. . . ." (Supp. Appeal Br. at 9.) Because the domains can comprise a variable number (viz., "N") of servers, we find that each server lacks knowledge of the other servers.

Furthermore, the server computers ("servers") are unable to directly communicate state information between themselves. Instead, the servers communicate

state information through a database. "As shown in Figure 1, the database 25 is accessible by each server computer 24 in the network," p. 7, ll. 20-21; "each server can access the information in the database that is set by other servers." P. 11, ll. 22-23.

2. Client and Server

The examiner finds, "Davis discloses an intermediary application . . . see Col. 4, lines 37-40 and lines 55-58." (Examiner's Answer at 3.) The appellants argue, "[i]n appellants' invention, the intermediary application acts as a middleman *between a client and a server*. In comparison, in Davis et al., the tracking program described therein is not disposed between a client and a server to receive transmissions exchanged between the client and the server." (Supp. Appeal Br. at 11-12.)

"[T]he Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). "[L]imitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Here, because the claim does not require "act[ing] as a middleman *between a client and a server*," (Supp. Appeal Br. at 11-12), we are unpersuaded by the appellants' argument. Therefore, we affirm the rejection of claim 1 and of claims 2-7, 22-27, and 42-46, which fall therewith.

The appellants further argue, "[c]laims 9 & 29, which depend from independent claims 1 & 22 are believed patentable for the same reasons discussed above in connection with the Group I claims." (Supp. Appeal Br. at 16.) Having been unpersuaded by those reasons, we affirm the rejection of claims 9 and 29.

3. Proprietary Protocol

The examiner asserts, "*Rosenberg* also discloses the claimed method wherein said non-cooperating domains do not [sic] share a [sic] proprietary protocol (see . . . page 4, lines 18-27, page 7, lines 1-8 and lines 20-23, please note that the fact that the first domain and the second domain are non-cooperating domains, and having no knowledge of one another, therefore, do not share a proprietary protocol)." (Examiner's Answer at 4.) The appellants argue, "[i]n *Rosenberg*, the domains . . . communicate a proprietary protocol between one another. . . . The proprietary protocol consists of generating, distributing, understanding and using, with a shared database, the unique identifier value." (Supp. Appeal Br. at 20.)

a. Claim Construction

"The general rule is, of course, that terms in the claim are to be given their ordinary and accustomed meaning." *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999) (citing *Renishaw PLC v.*

Marposs Societa Per Azioni, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998); *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996)). "It is well settled that dictionaries provide evidence of a claim term's 'ordinary meaning.'" *Inverness Med. Switz. GmbH v. Warner Lambert Co.*, 309 F.3d 1365, 1369, 64 USPQ2d 1926, 1930 (Fed. Cir. 2002) (citing *Texas Digital Sys. Inc. v. Telegenix Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002)).

Here, claims 51 and 52 recite in pertinent part the following limitations: "said non-cooperating domains do not share a proprietary protocol." The ordinary meaning of the term "proprietary" is "something [that] . . . will only work with one vendor's equipment." Harry Newton, *Newton's Telecom Dictionary* 603 (14th ed. 1998) (copy attached). Giving the term its ordinary meaning, the limitations require that the domains do not share a protocol that will only work with one vendor's equipment.

b. Obviousness Determination

"Argument in the brief does not take the place of evidence in the record." *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965) (citing *In re Cole*, 326 F.2d 769, 773, 140 USPQ 230, 233 (CCPA 1964)). Here, Rosenberg's "server

computers 24A-24N . . . observe a common protocol. . . ." P. 7, ll. 1-2. The appellants proffer no evidence, however, that the common protocol will only work with one vendor's equipment. To the contrary, the reference's invention operates "across distinct domains of the World Wide Web." P. 4, l. 27. "The World Wide Web . . . is a large collection of computers," p. 1, l. 2, not all of which use the same vendor's equipment. Because Rosenberg's method operates across domains/servers that use equipment from different vendor's, we find that its domains do not all share a proprietary protocol. Therefore, we affirm the rejection of claims 51 and 52.

B. CLAIMS 10-17, 30-37, AND 47-49

Admitting that "Rosenberg fails to disclose using *an intermediary application* to provide said state information to at least one of said client application and said server application," (Examiner's Answer at 11), the examiner asserts, "Davis discloses in col 4, lines 37-40 and lines 55-58, Fig 5, intermediary application, client, receives request from server A and transmits information to server B." (Supp. Examiner's Answer at 3.) The appellants argue, "the tracking program of Davis et al. is not disposed to receive transmissions exchanged between the client and the server, but instead simply monitors the user's interaction (e.g., keyboard presses, mouse clicks) with the client. . ." (Supp. Appeal Br. at 15.)

1. Claim Construction

Independent claim 10 recites in pertinent part the following limitations: "using the intermediary application, that [sic] is disposed to receive transmissions exchanged between said client and said server. . . ." Independent claims 30 and 47 recite similar limitations. Giving claims 10, 30, and 47 their broadest, reasonable construction, the limitations require that an intermediary application receive transmissions exchanged between a client and a server.

2. Obviousness Determination

"In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "*A prima facie* case of obviousness is established when the teachings from the prior art itself would . . . have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, we agree with the appellants that "the discussion of the tracking program reveals that it does not act as an intermediary between client and either of the Servers,

but rather initiates its own, independent communications with one of the servers. . . ."

(Supp. Appeal Br. at 15.) For example, Davis explains that "[t]he tracking program executes on a client machine, and is stored, for example, in RAM. The tracking program may monitor various indicia, such as time, mouse events, keyboard events, and the like, in order to track a user's interaction with the Web page." Col. 8, ll. 12-16. "When the user leaves the Web page . . . , the tracking program sends the monitored time to another computer on the Internet for storage and analysis." Col. 9, ll. 11-15.

Therefore, we reverse rejection of claim 10; of claims 11-17, which depend therefrom; of claim 30; of claims 31-37, which depend therefrom; of claim 47; and of claims 48 and 49, which depend therefrom.

C. CLAIMS 18-21, 38-41, AND 50

The examiner admits, "Giacoppo does not explicitly discloses [sic] said plurality of vendors comprising a plurality of non-cooperating domains, said non-cooperating domains having no knowledge of one another and wherein said non-cooperating domains do not directly communicate state information between another." (Examiner's Answer at 23.) Faced with this omission, he takes official notice that a "third party acting as host to offer as proxy service or clearinghouse for plurality of website where each website has no knowledge of one another is common in the Internet art." (*Id.*)

The examiner then asserts, "it would have been obvious . . . to implement Giacoppo's system with plurality of vendors where each vendors [sic] are not do not [sic] directly communicate state information with one another so that each vendor only need to deal with one central party instead of multiple parties." (*Id.* at 24.) The appellants argue, "[t]he vendors in Giacoppo are cooperating because they are all running Checkout! software. Therefore, they are communicating in a proprietary protocol and would have knowledge of one another." (Supp. Appeal Br. at 18.)

1. Claim Construction

Independent claims 18, 38, and 50 include limitations similar to those of claim 1. Accordingly, claims 18, 38, and 50 require domains having no knowledge of one another and being unable to communicate directly state information between themselves.

2. Obviousness Determination

"[I]t is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). Official notice may be employed "to supplement or clarify the teaching of a reference," *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 421 (CCPA 1970), "perhaps to justify or explain a particular inference

to be drawn from the reference. . . ." *Id.*, 165 USPQ at 421. A noticed fact usually is not employed as the principal evidence for a rejection, *id.*, 165 USPQ at 421, but "only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection." M.P.E.P. § 2144.03(E) (8th ed., rev. 1, Feb. 2003).

Here, rather than being insubstantial, sharing "state information . . . across non-cooperating domains," (Supp. Appeal Br. at 9 (emphasis added)), is the *raison d'être* of the appellants' invention. The appellants have expended extensive efforts to define "[t]he phrase 'non-cooperating domains' . . . in the application and the file history. . . ." (*Id.*) Furthermore, "[t]he meaning of non-cooperating is expressly recited in [each of] the independent claims. . . ." (*Id.* at 21.) Because the "non-cooperating" nature of the domains is important, it improper for the examiner to rely on official notice to teach the corresponding limitation.

The examiner does not allege, let alone show, that the addition of Davis or Krick-cures the aforementioned deficiency of Giacoppo. Absent a teaching or suggestion of domains having no knowledge of one another and being unable to communicate directly state information between themselves, we are unpersuaded of a *prima facie*

case of obviousness. Therefore, we reverse the rejections of claim 18; of claims 19-21, which depend therefrom; of claim 38; of claims 39-41, which depend therefrom, and of claim 50.

CONCLUSION

In summary, the rejections of claims 1-7, 9, 22-27, 29, 42-46, 51, and 52 under § 103(a) are affirmed. The rejections of claims 10-21, 30-41, and 47-50 under § 103(a), however, are reversed.

"Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences. . . ." 37 C.F.R. § 1.192(a). Accordingly, our affirmance is based only on the arguments made in the briefs. Any arguments or authorities not included therein are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

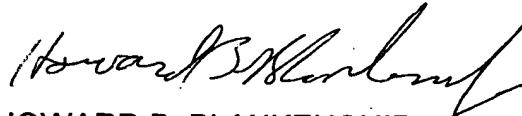


KENNETH W. HAIRSTON
Administrative Patent Judge



LANCE LEONARD BARRY
Administrative Patent Judge

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HOWARD B. BLANKENSHIP
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Appeal No. 2003-1031
Application No. 09/050,841

Page 19

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